

REMARKS/ARGUMENTS

This is responsive to the Office Action dated June 1, 2004. Currently, Claims 1-26 are pending with Claims 1, 9, 17, 25 and 26 being independent. Claims 1, 9 and 17 have been amended. The support for these amendments can be found on page 5 lines 10-17 and throughout the specification.

The Examiner rejected Claims 1-24 under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,721,284 Mottishaw et al. ("Mottishaw").

The Examiner rejected Claims 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over Mottishaw in view of US Patent No. 6,681,232 Sistanizadeh et al. ("Sistanizadeh").

These rejections are respectfully traversed for at least the reasons set forth below.

Applicants would like to take this opportunity to thank the Examiner for the courtesy extended to applicants during the September 29, 2004 telephone interview. During the interview, the Examiner indicated that if the claims were amended to clarify that the "indication" in Claims 1, 9 and 17 were displays that they would be novel over Mottishaw.

35 U.S.C. 103(a)

The Examiner rejected claims 1-24 as being unpatentable over Mottishaw. These rejections are respectfully traversed.

Claim 1 of the present invention recites an apparatus that obtains call trace information, comprising a network compatible device that is configured to communicate over a packet switched network with an end-point device. The network compatible device is configured to generate a request for call trace information that pertains to the end-point device and to receive the call trace information that was requested. The network compatible device also provides an indication of (displays) the call trace information that was received.

As indicated to the Examiner during the September 29, 2004 interview, the “indication of the call trace information” is not an acknowledgment signal, but rather an indication to the user (such as a display) of the information received. In an effort to further clarify this applicants have amended independent claims 1, 9 and 17 to state that the information (or at least part of the information) is displayed.

In contrast, Mottishaw describes a passive monitoring system which stores trace information. Mottishaw discloses a method of discovering the network configuration endpoints, gatekeepers and their relationships, for a communication system (such as telephony) carried by a PDN, by using a passive monitoring system to capture the signaling messages involved in configuration and negotiation of relationships, addressing and resource allocation, between endpoints and gatekeepers (*See* Column 1, lines 45-52). The system in Mottishaw does not dynamically send a call trace request as in the present invention.

Additionally, Mottishaw does not provide an indication of (display) the call trace that was received as in the present Claim 1. In contrast Mottishaw only stores the information in records. The invention in Mottishaw includes the monitoring of the multimedia channels to provide a service detail record for a session (*See* Column 2, lines 36-38). In addition, in Mottishaw the Data Management Infrastructure (DMI) is responsible for the storage of the service detail records. (*See* Column 3, lines 63-64).

Mottishaw does not disclose all of the elements of Claim 1 of the present invention and the rejection is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claim 1. Claims 9 and 17 were rejected for the same reasons as Claim 1. The rejection of Claims 9 and 17 are respectfully traversed for at least the same reasons as with respect to Claim 1. The Examiner is respectfully requested to reconsider and withdraw his

rejections of Claims 9 and 17. Claims 2-8, 10-16 and 18-24 depend on independent claims 1, 9 and 17 respectively. The rejection of claims 2-8, 10-16 and 18-24 is respectfully traversed for at least the same reasons with respect to claims 1, 9 and 17. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claims 2-8, 10-16 and 18-24.

The Examiner rejected Claims 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over Mottishaw in view of US Patent No. 6,681,232 Sistanizadeh et al. ("Sistanizadeh"). These rejections are respectfully traversed.

The deficiencies in Mottishaw were described above. Sistanizadeh does not cure the deficiencies in Mottishaw since Sistanizadeh discloses an automated service level manager (SLM) (*See* Abstract) and does not dynamically request call trace information as in the present invention.

Improper to Combine References:

The Examiner asserts that it would have been obvious to combine Mottishaw in view of Sistanizadeh so as to arrive at the present invention. However, there is no suggestion or motivation to combine the teachings of Mottishaw and Sistanizadeh. Mottishaw is directed at a method an apparatus for generating service detail records, and to monitoring systems for collecting data for these records from a network. (*See* Column 1, lines 5-7) Sistanizadeh is directed at operations support, provisioning and the like for managed IP services in a new IP over fiber to the premises type metropolitan area network. Thus, one skilled in the art, facing the problems that the Applicants faced would not combine these references as the Examiner suggests.

The Applicants respectfully point out to the Examiner, that the burden of proof lies with the Examiner to show such a teaching or suggestion to combine the references, other than in the present application. This is required as a matter of law:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that created the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art referenced for combination in the manner claimed. *In re Rouffet*, 149 F. 3d 1350, 1357 (Fed. Cir. 1998). *See also, In re Dembiczak*, 175 F. 3d 994, 99 (Fed. Cir. 1999) ('Combining prior art references without evidence of such a suggestion, teaching or motivation [to do so] simply takes the inventor's disclosure as blueprint for piecing together the prior art to defeat patentability - the essence of [impermissible] hindsight.').

As stated above, the burden of proof lies with the Examiner to show a motivation, other than the present application. The Examiner in the present case has not proffered a motivation in the reference or otherwise to combine Mottishaw and Sistanizadeh to arrive at the present invention.

The combination of Mottishaw and Sistanizadeh does not support a case of obviousness as suggested by the Examiner and the rejection is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claims 25 and 26.

Other Matter

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification

of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

Dated: October 1, 2004
New York, New York

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard M. Lehrer", written over a horizontal line.

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